REMARKS

Claims 11, 15 and 28 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-5, 8-9,16-20,29-32, 41 and 45-48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488) in view of Manross, Jr. (U. S. Patent No. 6,414,663). Claims 6-7, 21-22 and 33-34 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488) in view of Manross, Jr. (U. S. Patent No. 6,414,663) and further in view of O'Brien (U.S. Patent No. 6,055,569). Claims 10-15, 23-28, 35-40 and 42-44 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488) in view of Manross, Jr. (U. S. Patent No. 6,414,663) and further in view of Wants (U.S. Patent No. 6,008,727). Applicant respectfully traverses these rejections for at least the following reasons.

Claim Rejections Pursuant to 35 U.S.C. §112, second paragraph

Claims 11, 15 and 28 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection for at least the following reasons.

Applicant has amended Claims 11, 15 and 28 to alleviate the wording highlighted in the present Office Action. Applicant respectfully points out that these three claims have been unamended during prosecution, during which time there have been no less than four office actions issued. Applicant further submits that such a rejection after three previous office actions were issued in the present case is piecemeal prosecution and is not allowed. *See MPEP § 707.07(g).*

Claim Rejections Pursuant to 35 U.S.C. §103(a)

Claims 1-5, 8-9,16-20,29-32, 41 and 45-48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488) in view of Manross, Jr. (U. S. Patent No. 6,414,663). Claims 6-7, 21-22 and 33-34 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488) in view of Manross, Jr. (U. S. Patent No. 6,414,663) and further in view of O'Brien (U.S. Patent No. 6,055,569). Claims 10-15, 23-28, 35-40 and 42-44 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Assisi (U.S. Patent No. 5,696,488) in view of Manross, Jr. (U. S. Patent No. 6,414,663) and further in view of Wants (U.S. Patent No. 6,008,727). Applicant respectfully traverses these rejections for at least the following reasons.

35 U.S.C. §103(a) recites:

> [a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

> are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

Independent Claim 1 recites:

> 1. A system for providing instructions directly relating to a substantially immovable equipment at an inaccessible location, comprising:
> (A) a permanently spatially fixed processor and memory device affixed to the substantially immovable equipment, the instructions directly relating to a substantially immovable equipment residing on the memory device; and
> (B) a portable memory reading device, separate from the memory device, that retrieves the instructions from the memory device and communicates the instructions to a user of said portable memory reading device,
> wherein said processor processes the instructions to and from said memory device, including processing for forwarding of the

instructions from the memory device to said memory reading device.

[Emphasis Added].

The present invention claims "a system for providing instructions directly relating to a substantially immovable equipment at an inaccessible location," including "a permanently spatially fixed processor and memory device affixed to the equipment... wherein said processor processes the instructions to and from said memory device, including processing for forwarding of the instructions from the memory device to said memory reading device." *Claim 1.* As may be seen from the relevant portions of Claim 1, Applicants invention embodies a substantially stationary memory device affixed to a substantially stationary location or equipment with processing to control the flow of data to and from the memory device and to control the data forwarded to the memory reading device.

Applicant respectfully submits that Assisi does not teach a processor and memory device affixed to the substantially immovable equipment, as set forth in the present Office Action. *Office Action @ 3.* Since Assisi fails to teach a memory device substantially affixed to the immovable equipment as claimed in the present invention, it necessarily follows that Assisi also fails to teach a processor affixed to the immovable equipment for processing instruction to and from said memory device and for forwarding instruction from the memory device to the memory reading device. Applicant further submits that Manross – directed solely to a **Self-contained Electronic Memorial** – would not teach forwarding instructions from the memory device to a memory reading device, as claimed in the present Claim

1, at least because Manross does not have a memory reading device. The combination of Assisi and Manross fails to teach at least the limitation of wherein said processor processes the instructions to and from said memory device, including processing for forwarding of the instructions from the memory device to said memory reading device.

Consequently, Applicant traverses the 35 U.S.C. §103(a) rejection of Claim 1 and the dependents therefrom, deems the rejection overcome, and respectfully requests removal of the rejection. In addition, Applicant submits that independent Claim 1 is in a condition for allowance.

Applicant further submits that Assisi and Manross, alone or in combination, fail to teach, and therefore anticipate, Claims 2-15, at least because of these claims' ultimate dependence on patentably distinct base Claim 1. Applicant submits that each of Claims 2-15 are similarly in a condition for allowance.

Applicant further deems the rejections of Claims 16, 29 and 41 overcome for at least the reasons set forth with respect to Claim 1. In addition, Applicant submits that independent Claims 16, 29 and 41 are in a condition for allowance.

Applicant further submits that Assisi and Manross, alone or in any combinations, fail to teach, and therefore anticipate, Claims 17-28, 30-40 and 42-48 at least because of these claims' ultimate dependence on patentably distinct base Claim 16, 29 and 41, respectively. Applicant submits that each of Claims 17-28, 30-40 and 42-48 are similarly in a condition for allowance.

Conclusion

Applicant respectfully requests reconsideration of the present Application in light of the reasons set forth herein, and a Notice of Allowance for all pending claims is earnestly solicited.

Respectfully Submitted,

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